

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERHARD DIEKHAUS
and HARALD KAPPESSER

Appeal No. 1996-1288
Application 08/227,576¹

HEARD: Dec. 8, 1999

Before GARRIS, OWENS, and SPIEGEL, Administrative Patent
Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

¹Application for patent filed April 14, 1994. According to appellants, this application is a continuation of Application 07/975,706, filed November 13, 1992, now abandoned.

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This is a decision on an appeal from the refusal of the examiner to allow claims 2 through 6, 8 through 17, 19, 21 through 25 and 27 through 32 as amended subsequent to the final rejection.² These are all of the claims pending in the application.

The subject matter on appeal relates to a process for removal of sulfonated and unsulfonated organic phosphorous compounds from a starting solution which is a reaction product of sulfonation of aryl phosphines by sulfuric acid. The process comprises extraction of the sulfuric acid with 40 to 90 mol of a principal amine which is sparingly soluble or insoluble in water. This appealed subject matter is adequately illustrated by independent claim 28 which reads as follows:

28. A process for removal of sulfonated and unsulfonated organic phosphorus compounds from a starting solution which is a reaction product of sulfonation of aryl phosphines by sulfuric acid, which process comprises extraction of said sulfuric acid with 40 to 90 mol, per mol of the sulfonic acid radicals of said sulfonated organic phosphorus compounds

²By an apparently inadvertent oversight, the amendment-after-final filed March 29, 1995 has not been clerically entered notwithstanding the entry-authorization of the examiner in the advisory action mailed April 11, 1995. This oversight should be corrected upon return of the application to the jurisdiction of the examiner.

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contained in dissolved form in said acid, of a principal amine which is sparingly soluble or insoluble in water.

The following references are relied upon by the examiner as evidence of obviousness:

Connelly et al. (Connelly)	2,766,275	Oct. 9, 1956
Bodenbenner et al. 1976 (Bodenbenner)	3,992,247	Nov. 16,
Brunnmueller et al. 1981 (Brunnmueller) (EP)	0,041,134	Dec. 9,

Claim 28 is rejected under the first paragraph of 35 U.S.C. § 112 because "the specification, as originally filed, does not provide support for the invention as is now claimed" (answer, page 4). It is the examiner's basic position that "the specification only sets forth that the invention provides a procedure for removing sulfonated organic phosphorous compounds and other impurities from dilute sulfuric acid" (answer, page 4) and therefore does not support the claim 28 feature directed to "unsulfonated organic phosphorous compounds".

Claim 24 is rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention. According to the examiner, "[i]n claim 24, the word 'stoichiometric' implies a chemical reaction, but it is unclear what the reaction is" (answer, page 4).

Finally, claims 2 through 6, 8 through 17, 19, 21 through 25³ and 27 through 32 are rejected under 35 U.S.C. § 103 as being unpatentable over Brunnmueller in view of Connelly and Bodenbenner.

For the reasons which follow, we cannot sustain any of the above noted rejections.

The examiner has not clearly identified whether his section 112, first paragraph, rejection is based upon an enablement theory or a description theory. Although his criticisms seem more closely related to the latter, the

³Claims 21, 23 and 24 inappropriately depend from now cancelled claim 20. In accordance with the appellants' indication on page 2 of the brief, we will treat these claims as though they depend from claim 31 for purposes of resolving the issues before us on this appeal. However, in any further prosecution that may occur, the inappropriate dependency of claims 21, 23 and 24 should be corrected.

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examiner has failed to carry his burden of establishing that the rejection under consideration is proper under either theory. In essence, we agree with the appellants that the original disclosure of the subject specification including the disclosure relating to "other impurities" would have conveyed to an artisan that the appellants had possession on their application filing date of a process for removal of compounds which include unreacted compounds, namely, the claim 28 "unsulfonated organic phosphorous compounds". In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Additionally, assuming the examiner's concern regarding these last mentioned compounds relates to the issue of enablement, we point out that the examiner has failed to advance on this appeal reasoning inconsistent with enablement as is his burden. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982).

In light of the foregoing, we cannot sustain the examiner's section 112, first paragraph, rejection of claim 28.

We also cannot sustain the examiner's section 112, second paragraph, rejection of claim 24. On the record before us,

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the examiner has given no reason why the subject specification disclosure would not enable an artisan with ordinary skill to determine (without undue experimentation) the "reaction" or mechanism involved with the addition of an organic base to the amine solution. In re Strahilevitz, id. It follows that the examiner has provided us with no acceptable reasoning in support of his position that the artisan likewise would not be able to determine metes and bounds of the claim 24 requirement of a "stoichiometric amount" associated with this "reaction" or mechanism.

Finally, the section 103 rejection of all the appealed claims likewise cannot be sustained. This is because the examiner does not point to and we do not independently find any teaching or suggestion in the Brunnmueller reference which concerns the here claimed "process for removal of sulfonated and unsulfonated organic phosphorous compounds from a starting solution which is a reaction product of sulfonation of aryl phosphines by sulfuric acid, which process comprises extraction of said sulfuric acid with 40 to 90 mol . . . of a principal amine" (claim 28). Instead, Brunnmueller relates to a process for the separation of water-soluble salts of

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aromatic sulfonic acids from sulfating mixtures. Thus, the starting material of Brunnmueller's process includes aromatic sulfonic acids in sulfating mixtures which differs from the starting material of the appellants' here claimed process involving sulfonated and unsulfonated organic phosphorous compounds. Moreover, the examiner refers to nothing and we find nothing independently in our study of the secondary references to Connelly and Bodenbenner which supplies this deficiency of Brunnmueller. Indeed, the examiner does not address or even seem to appreciate this deficiency.

The decision of the examiner is reversed.

REVERSED

Bradley R. Garriss)
Administrative Patent Judge)
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PATENT	Terry J. Owens) BOARD OF
	Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
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